



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 09/890,715  
Appellant : Michael Butsch et al.  
Filed : December 31, 2001  
TC/A.U. : 3731  
Examiner : S. K. Webb

Confirmation No. 7784

Docket No. : 01-407  
Customer No. : 34704

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313

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A.F.  
#14  
Appeal Brief  
S. Butsch  
1/2/04

APPEAL BRIEF

Dear Sir:

This is an appeal to the Board of Patent Appeals and Interferences from the final rejection of the Examiner dated May 7, 2003.

REAL PARTY IN INTEREST

The real party in interest is Wittenstein GmbH & Co. KG.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant or Appellant's legal representative which would directly affect or be directly affected by or have a bearing on the Court of Appeals decision in the pending appeal.

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### STATUS OF CLAIMS

Claims 27-33 are the only claims pending in the application. All of the claims stand rejected and are on appeal. A true copy of the claims on appeal are attached hereto.

### STATUS OF AMENDMENTS

Applicants' Amendment Under 37 CFR 1.116 mailed August 6, 2003 has been entered for purposes of appeal as per the Examiner's Advisory Action dated September 4, 2003.

### SUMMARY OF INVENTION

The present invention is drawn to a cutting nozzle element having a radially arranged nozzle for receiving a severing medium in a pulsed manner for cutting bone or other biological structure (Page 2, lines 10-22). In accordance with the present invention as shown in Figure 2, at least one nozzle opening 13 is provided radially through which the severing medium flows out under very high pressure for severing, cutting or removal (Page 9, lines 17-22). The particular arrangement of the present invention wherein the cutting nozzle is radially deployed allows for easy manipulation of the cutting nozzle during operation. Also, by providing the radial nozzle as in accordance with the present invention, the material removed is easily withdrawn in an axial direction. A full discussion of the advantages are included for example on Pages 10-13 of the instant disclosure.

REFERENCES RELIED UPON BY EXAMINER

Patent No.	Patentee	Issue/Publication Date
US 5,853,384	Bair	December 29, 1998
US RE33,258	Onik et al.	July 10, 1990
EP 0 258 901	Kobayashi et al.	March 9, 1988

REJECTION OF RECORD

Claim 27 stands rejected under 35 USC 102 as being anticipated by  
US 5,853,384.

Claim 27 stands rejected under 35 USC 102 as being anticipated by EP 0 258 901.

Claims 28 and 29 stand rejected under 35 USC 102 as being anticipated by  
EP 0 258 901.

Claims 28-30, 32 and 33 stand rejected under 35 USC 103 as being unpatentable  
over US 5,853,384 in view of EP 0 258 901.

Claim 31 stands rejected under 35 USC 103 as being unpatentable over US  
5,853,384 in view of US RE33,258.

ISSUES ON APPEAL

- (1) Whether US 5,853,384 anticipates independent claim 27;
- (2) Whether EP 0 258 901 anticipates independent claim 27;
- (3) Whether claims 28 and 29 are anticipated by EP 0 258 901;
- (4) Whether claims 28-30, 32 and 33 are obvious under 35 USC 103 over US  
5,853,384 in view of EP 0 258 901; and
- (5) Whether claim 31 is obvious over US 5,853,384 in view of US RE33,258.

### GROUPING OF CLAIMS

Claim 27, and claims 30, 31, 32 and 33 are each separately patentable for reasons set forth in the Argument section of this appeal brief.

### ARGUMENT

(A) THE REJECTION OF CLAIM 27 UNDER 35 USC 102 AS BEING  
ANTICIPATED BY US 5,853,384 IS IMPROPER AND SHOULD BE  
WITHDRAWN.

Independent claim 27 clearly sets forth the following:

“...at least one nozzle extending radially with respect to the axis and communicating with the annular space, and further including means for reciprocating the shut-off element to provide a pulsed feed of fluid under pressure to the at least one radial nozzle.”

US 5,853,384 fails to teach, disclose, suggest or render obvious the foregoing structure as recited in independent claim 27.

The '384 patent does not teach or suggest delivering pulsed fluid under pressure via at least one radial nozzle. The Examiner in her rejection refers to vent 39 as shown in Figure 3. There is no means associated with the vent 39 for reciprocating a shut off valve element to provide a pulsed feed of fluid under pressure to the vent 39. To the contrary, the vent 39 is connected with low pressure 24. The nozzle which is equivalent to the claimed radial nozzle of independent claim 27 in the '384 patent is the cannula 22. The cannula 22 is an axial outlet for delivering cutting fluid under pressure axially. This is totally

contrary to the claimed subject matter of independent claim 27. Accordingly, the Examiner's rejection of independent claim 27 based on US 5,853,384 is improper and should be reversed.

(B) THE REJECTION UNDER 35 USC 102 OVER EP 0 258 901 IS IMPROPER AND SHOULD BE REVERSED.

Again the limitation in independent claim 27 referred to above in portion (A) of Applicants' Argument is incorporated herein by reference. Again, the EP 0 258 901 document is defective with respect to the critical limitation of independent claim 27. In the device of the EP document, fluid is delivered axially out of the handpiece 1. There is no teaching or suggestion for a radial nozzle as claimed in independent claim 27. Accordingly, the rejection of claim 27 based on the EP document is improper and should be reversed.

(C) THE REJECTION OF CLAIMS 28 AND 29 UNDER 35 USC 102 AS BEING ANTICIPATED BY EP 0 258 901 IS IMPROPER AND SHOULD BE REVERSED.

Initially it should be noted that the means for reciprocating as set forth in dependent claim 28 is not disclosed or rendered obvious by the EP document as it does not reciprocate a shut off element to provide pulsed fluid to a radial nozzle. In addition, the particular movement for feeding fluid under pressure to the annular space is not shown or suggested in the EP document. Finally, the gap between the shut off valve and the valve body as claimed in dependent claim 29

does not feed the fluid under pressure to a radial nozzle. Accordingly, the rejection of claims 28 and 29 over the EP document is improper and should be reversed.

#### CONCLUSION

None of the references cited by the Examiner teach, anticipate, suggest or render obvious the particular structure set forth in independent claim 27. Accordingly, it is respectfully submitted that the Examiner's rejection of independent claim 27 should be reversed.

#### ORAL HEARING

A Request for Oral Hearing with the appropriate fee was mailed on October 7, 2003 and received by the Patent Office on October 10, 2003.

#### APPEAL BRIEF FEE

A check in the amount of \$165.00 is enclosed to cover the Appeal Brief fee.

If any additional fees are required in connection with this case, it is respectfully requested that they be charged to Deposit Account No. 02-0184.

Respectfully submitted,

MICHAEL BUTSCH ET AL.

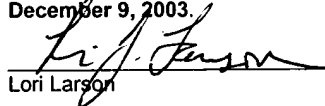
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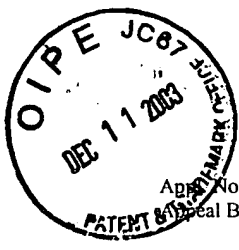
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IN TRIPLICATE

Date: December 9, 2003

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on December 9, 2003.

  
Lori Larson



App. No. 09/890,715  
Patent & Trade Brief dated Dec. 9, 2003

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## APPENDIX

Claim 27 (previously presented): A cutting-nozzle element for severing or removing a biological structure when the cutting-nozzle element is fed with a fluid under pressure, comprising a hollow cutting-nozzle body having an axis, the hollow cutting-nozzle body receives a shut-off element which is movable within the hollow cutting-nozzle body in a reciprocating manner along the axis wherein the hollow cutting-nozzle body defines with the shut-off element an annular space, at least one nozzle extending radially with respect to the axis and communicating with the annular space, and further including means for reciprocating the shut-off element to provide a pulsed feed of fluid under pressure to the at least one radial nozzle.

Claim 28 (previously presented): An element according to claim 27, wherein the means for reciprocating comprises (1) a biasing means for moving the shut-off element in a first direction and (2) means for selectively moving the shut-off element in a second direction opposite the first direction for feeding fluid under pressure in a pulsed manner to the annular space.

Claim 29 (previously presented): An element according to claim 28, wherein the means for selectively feeding comprises a variable gap formed between a surface of the shut off element and an inner wall of the cutting-nozzle body.

Claim 30 (previously presented): An element according to claim 29, wherein the means for selectively moving the shut-off element in the second direction comprises a motor means which



receives fluid under pressure via the variable gap.

Claim 31 (previously presented): An element according to claim 27, wherein the shut-off element has an internal passage for removing the fluid and biological structure.

Claim 32 (previously presented): An element according to claim 30, wherein the fluid motor means comprises a shoulder on the shut-off element which has a first surface which is acted on by the fluid under pressure.

Claim 33 (previously presented): An element according to claim 32, wherein the shoulder has a second surface which is acted on by the biasing means in opposition to the first surface.